

REMARKS

Claims 1-23 are pending in the present application. Claims 1-23 are rejected. In the above amendments, claims 1, 4-6, 9, 13, 16-20 and 23 have been amended. Claims 2-3, 14-15 and 21-22 have been canceled. Thus, after entry of the above amendments, claims 1, 4-13, 16-20 and 23 will be pending. Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

I. Claims 1, 3-12, 20 and 22-23 Rejected Under 35 U.S.C. § 112, second paragraph

Claims 1, 3-12, 20 and 22-23 stand rejected under 35 U.S.C. § 112, second paragraph. Claim 1 has been amended to recite “a multiplexer configured to multiplex the input data and the spread test data to the demodulator.” This amendment is supported by at least original claim 2 and Figure 2 of Applicant’s drawings. Claim 3 has been canceled. Claim 20 has been amended to recite “multiplexing the input data and the spread test data.” This amendment is supported by at least original claim 21 and Figure 2 of Applicant’s drawings. Claim 22 has been canceled. In view of these amendments, Applicant respectfully submits that claims 1, 4-12, 20 and 23 fully comply with the requirements of 35 U.S.C. § 112, second paragraph, and request that the rejection of these claims be withdrawn.

II. Claims 1-2, 13-14 and 20-21 Rejected Under 35 U.S.C. § 102(b)

Claims 1-2, 13-14 and 20-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0075945 to Farine et al. (hereinafter, “Farine”). In view of the above amendments to the claims and the following remarks, Applicant respectfully requests that the rejection of these claims be withdrawn.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition,

“the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Claim 1 recites “a demodulator configured to correlate an input data with a plurality of codes.” Claim 1 also recites “a test data pattern generator configured to spread an input test data with at least one of the plurality of codes.” Claim 1 has been amended to recite that “at least one of the plurality of codes comprises a scrambling code and a spreading code.” This amendment is supported by at least original claim 3, paragraph [0023] of Applicant’s specification and Figure 3 of Applicant’s drawings.

The Office Action acknowledges that Farine does not disclose that “at least one of the plurality of codes comprises a scrambling code and a spreading code,” as recited in claim 1. See Office Action, page 4. The Office Action asserts that this claimed subject matter is taught by U.S. Patent No. 7,123,590 to Mir (hereinafter, “Mir”). See id. However, Applicant respectfully submits that Mir does not preclude patentability of amended claim 1. Applicant refers to 35 U.S.C. § 103(c), which states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant respectfully submits that Mir qualifies as prior art only under 35 U.S.C. § 102(e). Applicant further submits that both Mir and the claimed invention were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to the assignee of the present application, QUALCOMM, Inc. Accordingly, under the provisions of 35 U.S.C. § 103(c), Mir does not preclude patentability of amended claim 1.

In view of the foregoing, Applicant respectfully submits that amended claim 1 is allowable. Accordingly, Applicant requests that the rejection of claim 1 be withdrawn.

Claim 2 has been canceled. Accordingly, Applicant requests that the rejection of claim 2 be withdrawn.

Claim 13 has been amended similarly to claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 13 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

Claim 14 has been canceled. Accordingly, Applicant requests that the rejection of claim 14 be withdrawn.

Claim 20 has been amended similarly to claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 20 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

Claim 21 has been canceled. Accordingly, Applicant requests that the rejection of claim 21 be withdrawn.

III. Claims 3, 15 and 22 Rejected Under 35 U.S.C. § 103(a)

Claims 3, 15 and 22 stand rejected under 35 U.S.C. § 103(a) based on Farine in view of U.S. Patent No. 7,123,590 to Mir (hereinafter, “Mir”). Claims 3, 15 and 22 have been canceled. Accordingly, Applicant requests that the rejection of claims 3, 15 and 22 be withdrawn.

IV. Claims 4 and 16 Rejected Under 35 U.S.C. § 103(a)

Claims 4 and 16 stand rejected under 35 U.S.C. § 103(a) based on Farine in view of Mir and further in view of Rahul Chauhan. Claim 4 depends from claim 1. Claim 16 depends from claim 13, which has been amended similarly to claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 4 and 16 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

V. Claim 11 Rejected Under 35 U.S.C. § 103(a)

Claim 11 stands rejected under 35 U.S.C. § 103(a) based on Farine in view of U.S. Patent Application Publication No. 2004/0001426 to Mailaender et al. (hereinafter, “Mailaender”). Claim 11 depends from claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 11 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

VI. Claims 5, 6, 12 and 17 Rejected Under 35 U.S.C. § 103(a)

Claims 5, 6, 12 and 17 stand rejected under 35 U.S.C. § 103(a) based on Farine in view of Mir and further in view of U.S. Patent No. 6,802,033 to Bertin et al. (hereinafter, “Bertin”). Claims 5, 6 and 12 depend from claim 1. Claim 17 depends from claim 13, which has been amended similarly to claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 5, 6, 12 and 17 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

VII. Claims 7-8, 18 and 23 Rejected Under 35 U.S.C. § 103(a)

Claims 7-8, 18 and 23 stand rejected under 35 U.S.C. § 103(a) based on Farine in view of U.S. Patent No. 7,151,944 to Hashem et al. (hereinafter, “Hashem”). Claims 7-8 depend from claim 1. Claim 18 depends from claim 13, which has been amended similarly to claim 1. Claim 23 depends from claim 20, which has been amended similarly to claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 7-8, 18 and 23 be withdrawn for at least the same reasons as those presented above in relation to claim 1.

VIII. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 9-10 and 19 include allowable subject matter. Claim 9 has been rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 10 depends from claim 9. Claim 19 has also been rewritten in independent form including all of the limitations of the base claim and any

intervening claims. Accordingly, Applicant respectfully submits the claims 9-10 and 19 are allowable.

IX. Conclusion

Applicant respectfully submits that the present application is now in condition for allowance. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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